

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yuichi TANEYA et al.

Application No.: 10/578,676

Confirmation No.: 3882

Filed: November 26, 2004 (Int'l)

Art Unit: 2617

For: MOBILE COMMUNICATION DEVICE AND
SCREEN SWITCHING METHOD FOR
MOBILE COMMUNICATION DEVICE

Examiner: M. Batista

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on March 5, 2010, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Kyocera Corporation

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

The undersigned is unaware of any other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 11 claims pending in the present application.

B. Current Status of Claims

- i.* Claims canceled: None
- ii.* Claims withdrawn from consideration but not canceled: None
- iii.* Claims pending: 1-11
- iv.* Claims allowed: None
- v.* Claims rejected: 1-11

C. Claims On Appeal

The claims on appeal are claims 1-11

IV. STATUS OF AMENDMENTS

No amendments remain outstanding. Applicant did not file an Amendment after the Final Rejection dated December 7, 2009.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is directed to an openable/closable mobile communication device having a first display screen and a second display screen that differ in screen size. (See *e.g.*, Figs. 4A and 4B, and the corresponding written description at paragraphs [0035]-[0036]). The communication device includes a storage unit operable to store data (storage unit 305 of Fig. 3); and a display control unit (display control unit 308 of Fig. 3) operable to read the data stored in the storage unit and display the data on the first display screen with a device main body in an opened state, read the same data and display the data on the second display screen with the device main body in a closed state, and determine whether a size of an image being displayed on the first display screen is larger than a size of the second display screen (see paragraphs [0029]-[0034] of the present specification). According to an embodiment of the present invention recited in claim 1, when the size of the image being displayed on the first display screen is less than or equal to the size of the second display screen, the display control unit does not perform size-reduction processing on the image when displaying the image on the second display screen (see Figs. 4A and 4B and paragraph [0035] of the present specification).

Independent claim 9 is directed to a screen switching method for an openable/closable mobile communication device having a first display screen and a second display screen that differ in screen size. (See *e.g.*, Fig. 6 and the corresponding written description, and Figs. 4A and 4B and the corresponding written description at paragraphs [0035]-[0036]). The method includes a recording step of recording data (Fig. 5, S504); and a display control step of reading the data recorded in the recording step (Fig. 5, S508) and displaying the data on the first display screen with a device main

body in an opened state (Fig. 5, S508), reading the same data and displaying the data on the second display screen with the device main body in a closed state (Fig. 5, S518 and Fig. 6, S612), and determining whether a size of an image being displayed on the first display screen is larger than a size of the second display screen (Fig. 6, S608). According to an embodiment of the present invention recited in claim 9, in the display control step, when the size of the image being displayed on the first display screen is less than or equal to the size of the second display screen, size-reduction processing is not performed on the image when displaying the image on the second display screen (Fig. 6, S612 and Figs. 4A and 4B).

Independent claim 10 is directed to an openable/closable mobile communication device having a first display screen and a second display screen that differ in screen size. (See *e.g.*, Figs. 4A and 4B, and the corresponding written description at paragraphs [0035]-[0036]). The communication device includes a storage unit operable to store data (storage unit 305 of Fig. 3); and a display control unit (display control unit 308 of Fig. 3) operable to read the data stored in the storage unit and display the data on the first display screen with a device main body in an opened state, read the same data and display the data on the second display screen with the device main body in a closed state, and determining whether a size of an image being displayed on the first display screen is larger than a size of the second display screen. (See paragraphs [0029]-[0034] of the present specification). According to an embodiment of the present invention as recited in claim 10, when the size of the image being displayed on the first display screen is less than or equal to the size of the second display screen, the display control unit displays the image on the second display screen at an original size of the image. (See Figs. 4A and 4B and paragraph [0035] of the present specification). Moreover, when the size of the image being displayed on the first display screen is greater than the size of the second display screen, the display control unit reduces the size of the image so that the entirety of the image can be displayed on the second display screen, and displays the reduced-size image on the second display screen (see paragraph [0036] of the present specification).

Accordingly, various embodiments of the present invention are configured to compare the size of an image in a first display screen with the screen size of a second display screen and, if it

is determined that the size of the image in the first display screen is less than or equal to the size of the second display screen, then maintaining the size of the image in the second display screen. Moreover, certain embodiments are configured to reduce the size of the image so that the entirety of the image can be displayed on the second display screen, and thereafter display the reduced-size image on the second display screen, when the size of the image being displayed on the first display screen is greater than the size of the second display screen.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-4, 6 and 9-11 are patentable under 35 U.S.C. §103(a) over Nakamura et al. (U.S. 2004/0023685) (hereinafter “Nakamura”) in view of Kawamura et al. (U.S. 2004/0198458) (hereinafter “Kawamura”); whether dependent claim 5 is patentable under 35 U.S.C. §103(a) over Nakamura in view of Kawamura, and further in view of Kurashina et al. (U.S. Patent no. 5,947,619); whether dependent claim 7 is patentable under 35 U.S.C. §103(a) over Nakamura in view of Kawamura, and further in view of Taniguchi et al. (U.S. 2004/0058715) (hereinafter “Taniguchi”); and whether dependent claim 8 is patentable under 35 U.S.C. §103(a) over Nakamura in view of Kawamura, and further in view of Okuzako et al. (U.S. 2004/0116167) (hereinafter “Okuzako”).

VII. ARGUMENT

Claims 1-11 stand rejected. Applicants request reversal.

A. Rejections of Claims 1-4, 6 and 9-11 Under 35 U.S.C. §103(a)

Claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Nakamura in view of Kawamura. It is submitted, however, that claim 1 is allowable over the cited combination of references. Applicants assert that the Examiner has failed to establish a *prima facie* case of obviousness because the Examiner has misinterpreted the cited art and the features of independent claim 1.

For convenience, independent claim 1 as previously presented is reproduced below:

1. An openable/closable mobile communication device having a first display screen and a second display screen that differ in screen size, comprising:
 - a storage unit operable to store data; and
 - a display control unit operable to read the data stored in the storage unit and display the data on the first display screen with a device main body in an opened state, read the same data and display the data on the second display screen with the device main body in a closed state, and determine whether a size of an image being displayed on the first display screen is larger than a size of the second display screen, wherein
 - when the size of the image being displayed on the first display screen is less than or equal to the size of the second display screen, the display control unit does not perform size-reduction processing on the image when displaying the image on the second display screen.

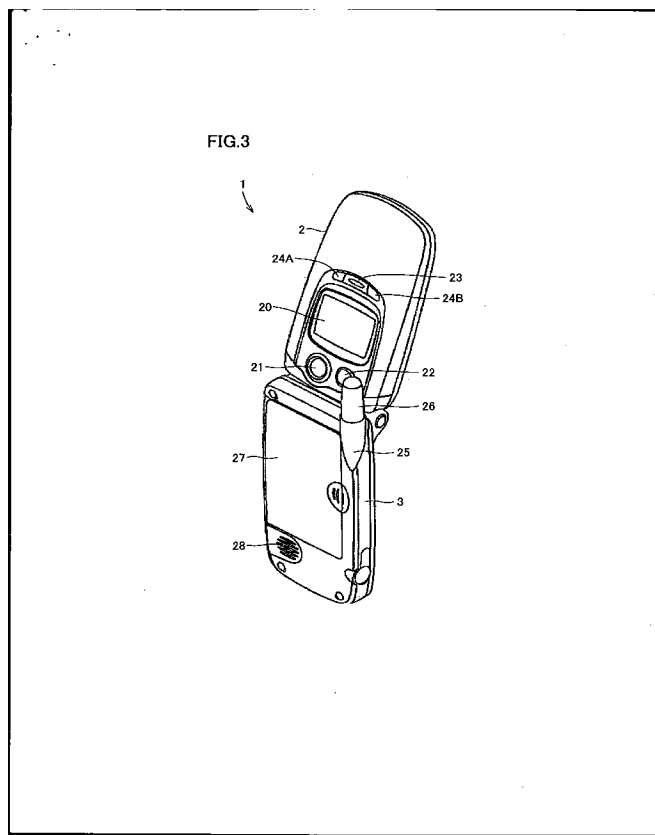
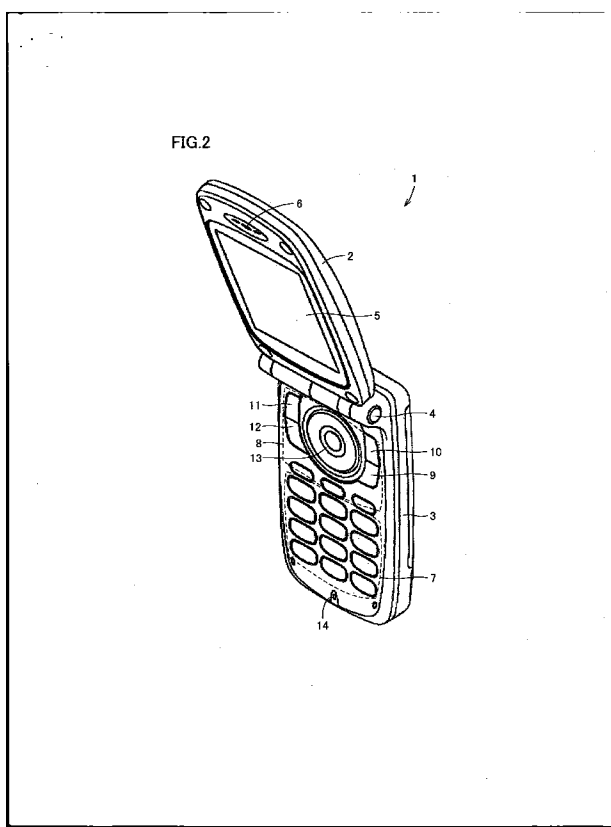
i. The Cited Art Fails to Teach or Suggest a Display Control Unit as Recited in Claim 1

In the Response to Arguments, on pages 2-3 of the final Action dated December 7, 2009, the Examiner states that Nakamura teaches a display control unit operable to determine whether a size of an image being displayed on the first display screen is larger than a size of the second display screen, citing paragraph [0107] and Figs. 2 and 3. In particular, the Examiner reasons that Nakamura discusses making a determination regarding whether to display an image in a first display or a second display, where the two displays are of different sizes. Thus, according to the Examiner, the teachings of Nakamura disclose that a size determination is made for the displayed image and adjusted accordingly.

Applicants respectfully disagree with the Examiner's interpretation of Nakamura and embodiments of the present invention. Independent claim 1 recites a display control unit operable to read the data stored in the storage unit and display the data on the first display screen with a device main body in an opened state, read the same data and display the data on the second display screen (different in size than the first display screen) with the device main body in a closed state, and *determine whether a size of an image being displayed on the first display screen is larger than a size of the second display screen*. If it is determined that the size of the image being displayed on

the first display screen is less than or equal to the size of the second display screen, no size-reduction processing is performed.

Nakamura is directed to a foldable cellular phone with first and second displays 5 and 20 configured to display images, where the second display 20 is smaller than the first display 5. (Abstract and Figs. 2 and 3). The cited portions of Nakamura provide that image data *in the shared memory* may be enlarged to provide data for the first display 5 and reduced to provide data for the second display 20. (Paragraph [0107]). It is first determined (S3) whether the image is to be displayed on the first display 5 or the second display 20, based on the position of a selector button (*e.g.*, determining whether the phone is open or closed). When it is determined that the phone is closed, the second display 20 is selected, thereby displaying a reduced-sized image. (Paragraph [0108]). Figs. 2 and 3 of Nakamura are reproduced below to show the first and second displays 5 and 20.



Thus, according to Nakamura, when it is determined that the second, smaller display 20 is to be employed, the reduced image data is *always* used, which provides a smaller image as compared to the first display. *Nakamura never compares an **image** being displayed on the first display screen with the **size** of the second display screen.* In fact, according to Nakamura, no image is ever displayed until the display screen is preselected.

The Examiner goes on to quote paragraph [0107] of Nakamura, which states

“In this embodiment, first memory 42 for first display portion 5 is independent of second memory 48 for second display portion 20. This is because the first and second display portions 5 and 20 are different in size of the screen and thus in size of displayed image from each other. However, instead of this structure employing the different memories for the first and second display portions, respectively, first and second display portions 5 and 20 may share a memory. **In this case, image data in the shared memory may be enlarged to provide data for first display portion 5, and may be reduced to provide data for second display portion 20.** More specifically, first and second display driver portions 43 and 44 may be provided with processing portions for the enlarging processing and the reducing processing described above, respectively.”
(Emphasis added)

According to the portion of Nakamura specifically pointed out by the Examiner, Nakamura is merely capable of fitting the image data to either a first display portion 5 or a second display portion 20. Nowhere in Nakamura is it taught or even suggested to read the data stored in the storage unit and display the data on the first display screen with a device main body in an opened state, read the same data and display the data on the second display screen (different in size than the first display screen) with the device main body in a closed state, and *determine whether a size of an image being displayed on the first display screen is larger than a size of the second display screen.* This is because the system of Nakamura is configured to determine which display portion to employ *before* display anything at all. Nakamura does not teach or suggest making an image size determination based on the size of the image and the size of the second display screen, but instead, the device of Nakamura always automatically reduces the image size, when the smaller display portion is employed.

Applicants further note that Kawamura is cited in the final Action dated December 7, 2009 as disclosing displaying an image of equal size on two different display screens (citing Fig. 1, and paragraphs [0060], [0087] and [0091]).

Kawamura discloses a video phone with a fixed display and a movable display part that can be opened to display the same image as is displayed in the fixed display. (See Figs. 1 and 2 and paragraph [0060]). However, the fixed and movable displays of Kawamura are the *same size*. That is, Kawamura does not teach or suggest that if it is determined that the size of the image being displayed on the first display screen is less than or equal to the size of the second display screen, no size-reduction processing is performed, *where the first and second display screens differ in size*, as required by independent claim 1. Therefore, Kawamura fails to cure the deficiencies of Nakamura described above.

Therefore, it is respectfully submitted that independent claim 1 patentably distinguishes over the cited references, alone or in combination. Independent claims 9 and 10 recite features substantially similar to those described above, and therefore Applicants request reversal of the rejections of all pending independent claims for at least the foregoing reasons.

Regarding dependent claims 2-8 and 11, Applicants assert that these claims include each limitation of their respective base claim and inherit the patentability thereof. Therefore, the dependent claims should be allowable for at least the foregoing reasons presented for independent claims 1, 9 and 10.

ii. *The Examiner Has Failed to Establish a Prima Facie Case of Obviousness*

In order to establish a *prima facie* case of obviousness based on a particular combination of references, the Examiner is required to provide a clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. §103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness

cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). (MPEP §2143).

In this case, the Examiner has merely provided a conclusory statement that "[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Nakamura and have it include displaying an image of equal size on two different display screens, as taught by Kawamura." (See, *e.g.*, page 7 of the final Action dated December 7, 2009). The Examiner reasons that the motivation would have been to be able to display the same information on both screens.

Applicants would like to point out that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). Further, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). For example, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (MPEP §2143.01).

In this case, Nakamura is directed to a foldable cellular phone with first and second displays 5 and 20 configured to display images, where the second display 20 is smaller than the first display 5. Accordingly, the invention of Nakamura is configured to reduce the size of an image to fit the smaller second display 20, when the foldable phone is in a closed state.

Kawamura is directed to a video phone with a fixed display and a movable display part that can be opened to display the image, as is displayed in the fixed display. (See Figs. 1 and 2).

The fixed and movable displays of Kawamura are configured to display the same image, as described in paragraph [0060]. Moreover, as the Examiner acknowledges on pages 4-5 of the final Action, the fixed and movable displays of Kawamura are the *same size*.

Therefore, there is no motivation to combine the teachings of Kawamura, which merely describes the ability to display the same image on different displays of *equal size*, with the teachings of Nakamura, which is directed to displaying a reduced size of an image to fit a smaller display when the foldable phone is in a closed state. Modifying the teachings of Nakamura with the ability to display an image on two, equal-sized displays clearly changes the principle of operation of the prior art invention being modified and makes Nakamura unsatisfactory for its intended purpose (*i.e.*, displaying a reduced size of an image to fit a smaller display). Thus, Applicants assert that the combination of these references is improper and the Examiner has failed to satisfy the requirements for establishing a *prima facie* case of obviousness. As a result, the rejections under 35 U.S.C. §103(a) must be reversed.

However, as discussed above, even assuming *arguendo* that these references may be properly combined, neither Nakamura nor Kawamura, alone or in combination, teaches or suggests making an image size determination based on the size of the image and the size of the second display screen, and if it is determined that the size of the image being displayed on the first display screen is less than or equal to the size of the second display screen, no size-reduction processing is performed. Nakamura always reduces the size of the image when it is displayed on the second display portion, whereas Kawamura never reduces the size of the image since its two display screens are the same size. Neither reference discloses or suggests making any size comparison whatsoever. Therefore, it is respectfully submitted that independent claims 1, 9 and 10, as well as the pending dependent claims, patentably distinguish over the cited references, alone or in combination.

B. Rejection of Claim 5 Under 35 U.S.C. §103(a)

Dependent claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Nakamura in view of Kawamura, and further in view of Kurishina. Dependent claim 5 inherits the patentability of independent claim 1 and is submitted to be allowable for at least the foregoing reasons presented herein. It is further submitted that Kurishina fails to cure the deficiencies of Nakamura and Kawamura described above and is not cited as doing such. Reversal of the rejection of dependent claim 5 is respectfully requested.

C. Rejection of Claim 7 Under 35 U.S.C. §103(a)

Dependent claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Nakamura in view of Kawamura, and further in view of Taniguchi. Dependent claim 7 inherits the patentability of independent claim 1 and is submitted to be allowable for at least the foregoing reasons presented herein. It is further submitted that Taniguchi fails to cure the deficiencies of Nakamura and Kawamura described above and is not cited as doing such. Reversal of the rejection of dependent claim 7 is respectfully requested.

D. Rejection of Claim 8 Under 35 U.S.C. §103(a)

Dependent claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Nakamura in view of Kawamura, and further in view of Okuzako. Dependent claim 8 inherits the patentability of independent claim 1 and is submitted to be allowable for at least the foregoing reasons presented herein. It is further submitted that Okuzako fails to cure the deficiencies of Nakamura and Kawamura described above and is not cited as doing such. Reversal of the rejection of dependent claim 8 is respectfully requested.

E. Conclusion

For the forgoing reasons, Applicants respectfully request reversal of the Examiner's

rejections of claims 1-11.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

IX. EVIDENCE

None.

X. RELATED PROCEEDINGS

None.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 278542014000. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: May 5, 2010

Respectfully submitted,

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/578,676

1. An openable/closable mobile communication device having a first display screen and a second display screen that differ in screen size, comprising:

a storage unit operable to store data; and

a display control unit operable to read the data stored in the storage unit and display the data on the first display screen with a device main body in an opened state, read the same data and display the data on the second display screen with the device main body in a closed state, and determine whether a size of an image being displayed on the first display screen is larger than a size of the second display screen, wherein

when the size of the image being displayed on the first display screen is less than or equal to the size of the second display screen, the display control unit does not perform size-reduction processing on the image when displaying the image on the second display screen.

2. The mobile communication device of claim 1, wherein
a screen size of the second display screen is smaller than a screen size of the first display screen.

3. The mobile communication device of claim 2, further comprising:
a detection unit operable to detect whether the device main body is in the opened state or the closed state, wherein

the display control unit includes a first storage subunit that corresponds to the screen size of the first display screen, and a second storage subunit that corresponds to the screen size of the second display screen,

when a notification of the opened state is received from the detection unit, the display control unit reads, from the storage unit, a desired web page which is the data, develops the web page to the first storage subunit as bitmap data, and displays the bitmap data on the first display screen, and

when a notification of the closed state is received from the detection unit, the display control unit reads the desired web page from the storage unit, develops the web page to the second storage subunit as bitmap data, and displays the bitmap data on the second display screen.

4. The mobile communication device of claim 3, wherein the display control unit sets a size of a character that is to be developed to the first storage subunit as bitmap data to a size specified by display information of the data stored in the storage unit, and changes a size of a character that is to be developed to the second storage subunit as bitmap data to a minimum size specified by the display information.

5. The mobile communication device of claim 4, wherein the size specified by the display information is one of 36x36 dot, 26x26 dot, 18x18 dot, and 12x12 dot, and the minimum size is 12x12 dot.

6. The mobile communication device of claim 3, wherein when a size of an image to be developed to the second storage subunit as bitmap data is larger than a size of the second storage subunit, the display control unit reduces the image to a size that can be held in the second storage subunit.

7. The mobile communication device of claim 1, wherein the data stored in the storage unit is web page content of a website, the content being acquired via a public network.

8. The mobile communication device of claim 7, wherein a five-point contact key for specifying a link in data displayed on the second display screen is provided on a same surface as the second display screen.

9. A screen switching method for an openable/closable mobile communication device having a first display screen and a second display screen that differ in screen size, comprising:

a recording step of recording data; and

a display control step of reading the data recorded in the recording step and displaying the data on the first display screen with a device main body in an opened state, reading the same data and displaying the data on the second display screen with the device main body in a closed state, and determining whether a size of an image being displayed on the first display screen is larger than a size of the second display screen, wherein

in the display control step, when the size of the image being displayed on the first display screen is less than or equal to the size of the second display screen, size-reduction processing is not performed on the image when displaying the image on the second display screen.

10. An openable/closable mobile communication device having a first display screen and a second display screen that differ in screen size, comprising:

a storage unit operable to store data; and

a display control unit operable to read the data stored in the storage unit and display the data on the first display screen with a device main body in a opened state, read the same data and display the data on the second display screen with the device main body in a closed state, and determining whether a size of an image being displayed on the first display screen is larger than a size of the second display screen, wherein,

when the size of the image being displayed on the first display screen is less than or equal to the size of the second display screen, the display control unit displays the image on the second display screen at an original size of the image, and

when the size of the image being displayed on the first display screen is greater than the size of the second display screen, the display control unit reduces the size of the image so as an entirety of the image can be displayed on the second display screen, and displays the reduced-size image on the second display screen.

11. The openable/closable mobile communication device of claim 1, wherein

the image has been generated based on the data stored in the storage unit and constitutes a portion of a display on the first display screen or on the second display screen.